



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/407,804 09/28/99 PELLETIER

J 241/190

HM22/1003

LYON AND LYON LLP  
633 WEST FIFTH STREET SUITE 4700  
LOS ANGELES CA 90071-2066

EXAMINER

TU, S

ART UNIT

PAPER NUMBER

1653

8

DATE MAILED:

10/03/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/407,804

Applicant(s)

PELLETIER ET AL.

Examiner

Stephen Tu

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-32 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

Art Unit: 1653

## **DETAILED ACTION**

### ***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a method for identifying the bacterial target of the product encoded by a bacteriophage 77 open reading frame, classified in class 435, subclass 6.
  - II. Claims 9, 10, 12, 13 and 14, drawn to various isolated, purified, or enriched nucleic acid sequences, and recombinant vectors and cells comprising a bacteriophage 77 open reading frame, classified in class 536, subclass 23.1.
  - III. Claim 11, drawn to an isolated, purified, or enriched polypeptide encoded by the bacteriophage 77 open reading frame, classified in class 530, subclass 300+.
  - IV. Claims 15-20 drawn to a method of identifying antibacterial agents active on the bacterial of , classified in class 435, subclass 7.4.
  - V. Claims 21-27, drawn to a method for inhibiting bacterium, classified in class 514, subclass 12+.
  - VI. Claims 28-30, drawn to an antibacterial agent, classified in class 514, and various subclasses thereof.
  - VII. Claims 31 and 32, drawn to a method of making an antibacterial agent, classified in class 435, subclass 69.1+, or class 530, subclass 333+.

The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1653

2. Inventions I, II, III, and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because each invention can be practiced independently of one another. With respect to the methods of Groups I and IV, each method is employed for a different purpose. Invention I is a method of identifying the bacterial targets of the product encoded by a bacteriophage 77 open reading frame, while Invention IV is a method of identifying agents that are active on those targets. The inventions clearly have different functions, as the identification of an antibacterial agent is a process that is distinct from the identification of the target for an antibacterial agent. Thus, the practice of one invention has no direct bearing on the practice of the other. Furthermore, it would be expected that the methods of the above inventions would be practiced under different reaction conditions. Thus, each of these inventions appears to involve significant considerations that are unique to each invention and which would address divergent subject matter in the art.

The particular requirements to practice the method of identifying suitable antibacterial agents would not be required in the process of treating of bacterial infections or the method of making the agent. Thus, Inventions I and IV are also unrelated to Inventions V and VII.

The inventions of Groups II and III are not related to the inventions of Groups I and IV. The methods of Invention I and IV are not directed to a process of using, making or identifying the products of Inventions II and III.

Art Unit: 1653

3. The inventions of Groups II and III are patentably distinct from each other because of the materially different structures of the compounds claimed. The invention of Group II is drawn to a polynucleotide, while the invention of group III is drawn to a polypeptide. The compounds that are the subject of each group are independent and/or patentable distinct from each other because each compound is structurally distinct. Th compounds of each invention would be expected to exhibit different physico-chemical properties, and are capable of separate manufacture or use.

The term "distinct" means that two or more subjects as disclosed are related but are capable of separate manufacture, use, or sale as claims, and are patentable (novel and unobvious) over each other, though they may each be unpatentable because of the prior art (MPEP 802.01).

Inventions II and III are unrelated to Inventions V, VI, and VII. The products of Inventions II and III are structurally distinct from the product of Invention VI, and are not involved in the methods of Inventions V and VII, as Inventions II and III are not products that possess antibacterial properties.

4. Inventions IV and VI are patentably distinct from each other. Invention IV is essentially a method of assaying for an antibacterial agent. This process of identifying does not involve the use of the product of claim VI *per se*, rather, the product is a by-product of the process. Once identified, the product itself is produced using the method of Invention VII, and can be used in materially different processes, namely as a therapeutic compound. The method of Invention IV would also involve different functions, as the identification of an antibacterial agent is distinct from the antibacterial agent. Furthermore, it would be expected that Invention IV would be practiced under different conditions from the process of treatment or making the product of

Art Unit: 1653

Invention VI. Thus, each of these inventions appears to involve significant considerations that are unique to each invention and which would address divergent subject matter in the art.

5. Inventions V and VI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, other materially different compounds are known in the art that are also capable of inhibiting the growth of bacteria, such as myristoyl-L-methionine (a fatty N-acylamino acid). Similarly, there are other compounds known in the art that are routinely used to treat bacterial infections.

6. Inventions V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because each invention can be practiced independently of one another. One can practice the method of inhibiting bacterial growth independently of the method of making the antibacterial agent. The inventions clearly have different functions, as the inhibition of bacteria is a process that is distinct from the production of an antibacterial agent. Thus, the practice of one invention has no direct bearing of the practice of the other. The methods of the above inventions would be practiced using different cells and under different reaction conditions. Thus, each of these inventions involves significant considerations that are unique to each invention and which would address divergent subject matter in the art.

Art Unit: 1653

7. Inventions VI and VII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the chemical composition and properties of the claimed product are unknown, but presumably it would be a peptide. A variety of methods, recombinant and non-recombinant, are known in the art to synthesize peptides.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for any one Group is not required for each of the other Groups, restriction for examination purposes as indicated is proper.

8. A telephone call was made to Wesley Ames on 19 September 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

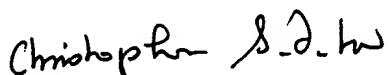
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Tu whose telephone number is 703-308-3968. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

Art Unit: 1653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 703-308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

ST  
September 29, 2000

  
CHRISTOPHER S. F. LOW  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600